



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/091,735	06/24/98	BRAMHILL	36-1230

NIXON & VANDERHYE
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON VA 22201-4714

TM11/1025

EXAMINER

NGUYEN, C

ART UNIT PAPER NUMBER

2165

7

DATE MAILED: 10/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/091,735

Applicant(s)

Bramhill et al.

Examiner

Cuong H. Nguyen

Group Art Unit

2165



☒ Responsive to communication(s) filed on Jun 20, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-30 is/are pending in the application

Of the above, claim(s) 9-11, 13, 19, 20, and 27 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8, 12, 14-18, 21-26, and 28-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Serial Number: 09/091,735

Art Unit: 2165

DETAILED ACTION

1. This Office Action is the answer to the amendment received on 6/20/2000; which paper has been placed of record.

2. Claims 1-30 are pending in this application; claims 9-11, 13, 19-20, and 27 have been canceled; claims 28-30 have been added.

Response to the amendment:

3. Applicants' arguments received on 6/20/2000 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C. § 103(a) rejections because whether being obvious or directly/indirectly stated, the subject matter already were available through prior art.

4. Applicants' amendment (for claim 30, wherein "suppress a client copy with respect to an unprotected copy of the requested data") necessitated a new ground of rejection presented in this Office Action (see US. Pats. 4,584,665 of Vrieling, 5,359,659 of Rosenthal, and 5,748,731 of Shepherd for that subject matter's suggestion).

5. In the amendment received on 6/20/2000 on page 10, applicants argue that "there is no basis in any of three references for the conclusions reached by the Examiner..."; the examiner disagrees since previous claims 1-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over unpatentable over Yourdon, in view of

Serial Number: 09/091,735

Art Unit: 2165

Dean et al., Wobber et al. (U.S. Pat. 5,235,642), and further in view of Richardson (PCT WO-A-9407204). These references became at least obvious/analogous/similar applications in data processing/computer/communication areas of their technique in achieving claimed results; and the examiner sees there is nothing inappropriate to cite these references because they actually are related to claims' subject matters, moreover the applicant did considering these prior art by submitting them for consideration in a related PCT application.

Separate cited references might not expressly disclose exactly claimed languages as of the applicants.

However, the examiner also submits that all claimed's limitations are well-known in the art (see extra cited references); cited prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior references are also directed to a similar system/method for protecting downloaded data. Cited prior arts are not limited to the described embodiments in these references.

It is reasonable that various modifications and variations of prior art would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of these references. Although these cited prior art have been described in connection with specific preferred embodiments, it

Serial Number: 09/091,735

Art Unit: 2165

should be understood that their limitations should not be unduly limited to such specific embodiments. Furthermore, in response to the amendment, the examiner submits court cases (see the remark portion) which are relevant to applicants' arguments. These court cases are decisions of 35 U.S.C. § 103(a) rejections of this application.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 12, 14-18, 21-26, 28-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yourdon, in view of Dean et al., Wobber et al. (U.S. Pat.5,235,642), and further in view of Richardson (PCT WO-A-9407204), and the Official Notice.

Yourdon suggests ideas of dealing about security on the Internet (see Yourdon pg. 28, cols.1-2 about **Security**), he submits that applications should ensure "secure access to functionality and data, as well as secure transmission of data across the Internet". Adding digital signatures to applets is contemplated, such that a user can be sure of the source and

Serial Number: 09/091,735

Art Unit: 2165

origin of a downloaded applets. As typical for a client server application, a password may be asked "to determine the end user's authorization to invoke certain functionalities of access certain data", and "the application will interact with the browser to encrypt/decrypt transmissions between the client and the server". He further proposes to integrate encryption packages like PGP into Internet applications and achieve higher security with a public key password system.

Dean et al. contribute ideas about security issues raised in Web browsers such as HotJava and Netscape by server supplied code constituted by Java applets downloaded to and run inside the Web browsers. "In Netscape, Java applets can name only those functions and variables explicitly exported to the Java subsystem". They further suggest that Java would be more secure if encryption was used.

Both Yourdon and Dean et al. talk about encryption, and hashing is known in the art as a similar security measure ensuring integrity of data. Yourdon also suggests hashing by proposing to add signatures to information downloaded from the Web such that the receiving side can be sure of its source and origin, thus of its integrity.

Both Yourdon and Dean et al. suggests method and systems for ensuring security of functionality and data in a client-server

Serial Number: 09/091,735
Art Unit: 2165

environment - in particular the Internet. However they do not directly address the specific problem of protecting from copying data, & authentication which have been downloaded from a server to a client, nor its solution as in claim 1.

Wobber et al. proposes to achieve access control using copies of clients credentials cached at the server for future use. The security system includes a computer at each node of the distributed system with a trusted computing base that includes an authentication agent for authenticating requests received from principals at other nodes in the system. Requests are transmitted to servers as messages that include a first identifier (i.e. Auth ID) provided by the requester and a second identifier (called the subchannel value) provided by the requester and a second identifier (called the subchannel value) provided by the authentication agent of the requester node. Each server process has an associated local cache that identifies requesters whose previous request messages have been authenticated. When a request is received, the server checks the request's two identifiers against the entries in its local cache. If there is a match, the request is known to be authentic without having to obtain authentication from the requester's node.

It is held that one with skills in the art would need no inventive activity to infer from the general teachings of Yourdon

Serial Number: 09/091,735
Art Unit: 2165

("to determine the end user's authorization to invoke certain functionalities of access certain data", and Dean et al.

("applets can name only those functions and variables explicitly exported to the Java sub-system", at least when taken in combination, that a solution consists in selectively controlling copying functions of the client in respect of the downloaded data, hence arriving at the subject matter of claim 1.

8. As per claims 5-6, 17: Yourdon, Richardson, and Wobber et al. also teaches about password, public key, password system that claimed. Therefore, the same reasoning applies for identifying/authorizing/registering a client to a server.

9. As per claims 7-8: Gosling (EP 0718761 A1) also discloses the downloading of a program. This feature is well-known in the art.

10. As per claims 9-16: Bender et al. also disclose about steganographically marking data (claim 16); this feature is also well-known in the art. The Official Notice is taken that the feature of claims 9-13, and the use of a cryptographic key are well-known in the art.

Conclusion

11. Claims 1-8, 12, 14-18, 21-26, 28-30 are rejected.

Serial Number: 09/091,735

Art Unit: 2165

12. The attached references are considered pertinent to applicant's disclosure.

13. Remarks:

A. About making a component "poratable":

In re **Lindberg**, 93 USPQ 23 (CCPA 1952), the court said: Moreover, even if this feature were properly recited in the appealed claims, as pointed out by the Solicitor of the Patent Office in his brief, this in itself would not render the claims patentable since it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. See *Rance, Inc. V. Gwynn et al.*, 128 F. 2d 437 (54 USPQ 3).

B. In re **Heck**, 216 USPO 1038 (CA FC 1983)

Similarly relative terms in claims are given broadest reasonable interpretation during patent application's prosecution.

C. In re **Keller, Terry, and Davies**, 208 USPO 871 (CCPA 1981)

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested

Serial Number: 09/091,735
Art Unit: 2165

in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

D. Ex parte Rubin, 5 USPQ2d 1461 (BdPatApp&Int 1987):

Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

E. In re Susi, 169 USPO 423 (CCPA 1971): Disclosed examples and preferred embodiments do not constitute a teaching away from a broadier disclosure or non-preferred embodiments.

F. In re Heck, 216 USPO 1038 (Fed. Cir. 1983): "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

G. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); in this application, it is so obvious to one with skills in the art to apply these limitations in a condition of non-networked accessing).

Serial Number: 09/091,735

Art Unit: 2165

H. About carrying forward another's invention--Design choice to make integral:

In re **Larson**, 144 USPQ 347 (CCPA 1965), the court said:

"While the brake disc and clamp of Tuttle et al. comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole. Webster's New International Dictionary (2nd edition) defines "integral" as "(2) composed of constituent parts making a whole; composite; integrated." We are inclined to agree with the board's construction of the term "integral" as used in claim 12. Then, too, we are inclined to agree with the position of the solicitor that the use of a one piece construction instead of the structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice. In re **Fridolph**, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319; and in re Lockhart, 90 USPQ 214 (CCPA 1951) the court said: After a careful examination of the record, we do not find ourselves in agreement with appellant's argument. Although it is true that invention may be present under some circumstances in making integral that which was separate before, we do not feel that such is the case here. Improved results only will not take the case out of the general rule. There is also a requirement that the unification or integration involve more than

Serial Number: 09/091,735

Art Unit: 2165

mere mechanical skill. In re **Murray**, 19 CCPA 739, 53 F.2d 541, 11 USPQ 155; In re **Zabel et al.**, 38 CCPA 832, 186 F.2d 735, 88 USPQ 367. In this case, all of the essential elements of the appealed claims except integration of parts, are found in the references. It appears to us that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the syringe, than on any inventive concept.

and in **Howard v. Detroit Stove Works**, 150 US 164 (CCPA 1893), the court said: "As to the 3rd patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together, nor to make the shape of the grate correspond with that of the firepot".

I. MPEP 2113 Product-by-Process Claims (in claims 1, 10, 20):

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the

Serial Number: 09/091,735
Art Unit: 2165

prior art product was made by a different process." In re Thorpe,
227 USPQ 964 (Fed. Cir. 1985).

J. The functions perform on this apparatus/system needs internal dedicated software that allows it to store, organize, retrieve, and transfer electronic money .etc., as computers cannot perform storage and retrieval functions without software. Any retrieval and storage function by computers would necessitate dedicated software, which the application does not disclose.

K. The examiner submits that the reasons for rejection are inherent and obvious v.s. cited prior arts. One of ordinary skills in the art at the time of the invention would have found these claim's limitations would be very obvious with inherent steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior arts are also directed to a similar process for obtaining job applications from remotely located applicants. These prior arts are not limited to the described embodiments in these inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited inventions have been described in connection with specific

Serial Number: 09/091,735

Art Unit: 2165

or faxed to: (703) 308-9051, (for formal communications)

Or: (703) 305-0040 (for informal or draft communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Cuong H. Nguyen', with a long, sweeping flourish extending from the end of the name.

Cuong H. Nguyen
Oct. 08, 2000